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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,079	11/30/2001	Yoon Kean Wong	035451-0165 (3703.Palm)	4525
26371	7590	09/19/2005	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			PHAM, TUAN	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,079

Applicant(s)

WONG ET AL.

Examiner

TUAN A. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-21, and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 6-17-2007 have been fully considered but they are not persuasive.

In response to applicant's remark on page 6, Applicant argues that there is no motivation to combine of Albuquerk's reference and Colson's reference.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the reference. Rather, the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art. Albuquerk teaches a personal interpretive device is included a storage for retrieving the information includes text data, graphic data, and audio data.

Colson teaches a system and program priority data for storing in the database.

Therefore, there is a motivation to combine the teaching of Albuquerk and Colson since the device can be store and process the priority data.

In response to applicant's arguments against the references Colson et al. individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's remark on page 6-7, Applicant argues that the prioritized information in Colson is on the computer device, not on the PDA.

In response to applicant's arguments as stated above, the Examiner respectfully disagrees with the Applicant's argument. Applicant should refer to claims 1, 11, and 21, there is nowhere in the claims includes a PDA. Applicant claimed "portable device", not PDA. It has been recognized In re Lindberg, 93 USPQ 23 (CCPA 1952) that it is not regarded as inventive to merely made an old device portable or movable without producing any new and unexpected resulted. Also, any device which can be moved by hand is "portable", and the Colson device can certainly be moved by hand. Furthermore, Webster's II New Riverside University Dictionary defines "portable" as "1. Capable of being carried. 2. Easily carried or moved. 3. Something portable, as a light typewriter or television".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. **Claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848, hereinafter, "Albukerk") in view of Colson et al. (Pub. No.: US 2002/0078075, hereinafter, "Colson").**

Regarding claim 1, 11, and 21, Albuberk teaches a method and a portable electronic device, comprising: a processor (see figure 2, PID 101, processor 207, col.9, ln.16-18); a transceiver coupled to the processor (see figure 2, transmitter 217, receiver 203), the transceiver configured to receive and transmit communication signals (see

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figure 2, transmitter 217, receiver 203); a memory coupled to the processor (see figure 2, memory 209, processor 207); and a program stored in the memory and running on the processor configured to receive an association signal by the transceiver (see col.10, ln.53-67), the association signal providing an indication of adjacent resources (see figure 1, object identification device 107a send a resource signal to PID 101a, the signal 109a is associated with object 103a, col.9, ln.23-54), the program further configured to access a database including a table storing relationships between data stored on the portable electronic device and the association signal (see figure 1, col.9, ln.10-54, when PID 101a receives the signal from OID 107a, the processor will access to the storage device 205 for checking the associated data that corresponding to the receiving signal), and the program configured to index the data based on the relationships accessed in the database (see figure 4, col.10, ln.11-53, i.e., index is corresponding objected identifier 401, objected type 403).

It should be noticed that Albuberk fails to teach the prioritizing data. However, Colson teaches such features (see figure 1, prioritization system 10, [0023, 0045]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albuberk, in order to store and process the priority data from the database.

Regarding claims 3, 7, 13, 18, and 23, Albuberk further teaches the method and portable electronic device, wherein the association signal includes a signal from a wireless access point (see figure 1, OID 107a, col.8, ln.14-29).

Regarding claims 8, 16, and 26, Albuberk further teaches the method and portable electronic device, wherein the association signal includes an infrared signal (see col.8, ln.25).

Regarding claims 9, 19, and 28, Albuberk further teaches the method and portable electronic device, further comprising: retrieving data stored on the portable electronic device and related to the associating signal (see col.9, ln.10-31).

Regarding claims 10, 20 and 29, Albuberk further teaches the method and portable electronic device further comprising: displaying the data retrieved (see col.11, ln.15-25).

4. Claims 4-6, 14-15, 17, 24-25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albukerk et al. (U.S. Patent No.: 5,929,848, hereinafter, "Albukerk") in view of Schulze et al. (Pub. No.: US 2002/0019584, hereinafter, "Schulze").

Regarding claims 4, 14, and 24, Albuberk teaches a method and a portable electronic device, comprising: a processor (see figure 2, PID 101, processor 207, col.9, ln.16-18); a transceiver coupled to the processor (see figure 2, transmitter 217, receiver 203), the transceiver configured to receive and transmit communication signals (see figure 2, transmitter 217, receiver 203); a memory coupled to the processor (see figure 2, memory 209, processor 207); and a program stored in the memory and running on the processor configured to receive an association signal by the transceiver (see col.10, ln.53-67), the association signal providing an indication of adjacent resources (see

figure 1, object identification device 107a send a resource signal to PID 101a, the signal 109a is associated with object 103a, col.9, ln.23-54), the program further configured to access a database including a table storing relationships between data stored on the portable electronic device and the association signal (see figure 1, col.9, ln.10-54, when PID 101a receives the signal from OID 107a, the processor will access to the storage device 205 for checking the associated data that corresponding to the receiving signal), and the program configured to index the data based on the relationships accessed in the database (see figure 4, col.10, ln.11-53, i.e., index is corresponding objected identifier 401, objected type 403).

It should be noticed that Albuberk fails to teach the association signal includes a Bluetooth signal. However, Schulze teaches such features (see col.13, [0174]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Schulze into view of Albuberk, in order to communicate in short range.

Regarding claims 5, 15, and 25, Schulze further teaches the method and portable electronic device wherein the association signal includes an IEEE 802.11 signal (see col.13, [0174]).

Regarding claims 6, 17, and 27, Schulze further teaches the method and portable electronic device wherein the association signal includes a biometric signal (see col.13, [0174]).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (571) 272-8097. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (571) 272-7499 and

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Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit 2643
September 06, 2005
Examiner

Tuan Pham



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